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10/589,279	08/11/2006	Peter Euteneuer	016790-0508	5722

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EXAMINER
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FINEMAN, LEE A

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2872

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/589,279	<b>Applicant(s)</b> EUTENEUER ET AL.	
	<b>Examiner</b> LEE FINEMAN	<b>Art Unit</b> 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/11/06 & 9/2/08 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/23/08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This Office Action is in response to an amendment filed 2 September 2008 in which claims 1-8 and 11-15 were amended. Claims 1-17 are pending.

#### ***Drawings***

1. A replacement drawing for fig. 3 was received on 2 September 2008. This drawing is acceptable.

#### ***Claim Objections***

2. Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 10 contains the exact same limitation as claim 9 from which it depends.

3. Claims 1-17 are objected to because of the following informalities:

Regarding claim 1, the limitation "the user's position" lacks antecedent basis.

The dependent claims inherit the deficiencies of the claims from which they depend.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-8 and 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Baumann et al., US 5,657,158 (henceforth Baumann).

Regarding claim 1, Baumann discloses in fig. 2 a tube for a microscope comprising an objective (7) defining an objective optical path (22), the tube defining a tube optical path (fig. 2), a binocular head (12) provided at the tube defining an ocular optical path (fig. 2), a deflection element (1) being provided in the tube optical path (fig. 2), wherein a deflection mirror (2) is provided behind the objective optical path (22), when viewed from the user's position (fig. 2), wherein a single tube-lens system (L1, L2) is positioned in the tube optical path (fig. 2) and a modification to the inclination of the ocular optical path in relation to the horizontal by a value  $\alpha$  causes the position of the deflection mirror (2) to be modified by an angle  $\alpha/2$  (column 3, lines 24-26).

Regarding claim 2, Baumann further discloses wherein the single tube-lens system (L1, L2) is positioned at the microscope (fig. 2) in a region of a connection element (5) in front of the deflection element (1).

Regarding claim 3, Baumann further discloses wherein the binocular head (12) has two eyepieces (18 and 19, see fig. 3), an intermediate image (4) is configured to be created in each of the eyepieces fig. 3) and the distance from a lens vertex of the single tube-lens system (L1, L2)

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to the intermediate image (4) is not greater than 1.25 times a focal distance of the tube-lens system (column 3, line 41-53, column 4, lines 24-40).

Regarding claims 4-5, Baumann further discloses wherein the deflection mirror (2) and the binocular head (12) are pivotably embodied and the pivoting movement thereof is constrainedly coupled and wherein a constrained coupling between the deflection mirror (2) and the binocular head (12) is embodied so that the deflection mirror (2) pivots by an angle value  $\alpha/2$  when the binocular head (12) is pivoted by the angle  $\alpha$  (column 3, lines 24-32).

Regarding claim 6, Baumann further discloses wherein the deflection mirror (2) defines a pivot axis that runs in the middle of a reflecting surface of the deflection mirror (fig. 2).

Regarding claims 7 and 8, Baumann further discloses wherein the binocular head (12) has an adjustable range of the angle  $\alpha$  between the horizontal and the ocular optical path of slightly over  $0^\circ$  to  $32.5^\circ$  (fig. 2); and wherein the adjustable range of the angle  $\alpha$  lies between  $7.5^\circ$  to  $32.5^\circ$  (fig. 2).

Regarding claims 12 and 13, Baumann further discloses wherein a holding element (not shown, inherently there has to be some element attaching these pieces to the outside supports (frame, see claim 1) because they cannot float in air) is provided on which the deflection element (1), which is a prism, and the deflection mirror (20) are mounted (frame, see claim 1).

Regarding claims 14, 15 and 16, Baumann further discloses wherein the holding element (not shown) is surrounded by a housing (frame, see claim 1) comprising a lower housing part (where 5 is attached) and an upper housing part (where 6 is attached); wherein the upper housing part has a recess (fig. 2) into which a mounting part (6) for the binocular head (12) can be

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inserted; and wherein the binocular head (12) as well as the single tube-lens system (L1 and L2) are attached in or on the holding element (frame, see claim 1).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann.

Baumann discloses the claimed invention except the distance between the deflection element and the deflection mirror being in the range of between 0.125 times and 0.150 times the focal distance of the single tube-lens system. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the distance between the deflection element and the deflection mirror be in the range of between 0.125 times and 0.150 times the focal distance of the single tube-lens system, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering an optimum value or working ranges involves only routine skill in the art. One would have been motivated to make the distance between the deflection element and the deflection mirror be in the range of between 0.125 times and 0.150 times the focal distance of the single tube-lens system for the purpose of making a compact device. *In re Aller*, 220 F.2d 454, 456 105 USPQ 233, 235.

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8. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann in view of Blaha et al., US 4,175,826 (henceforth Blaha).

Baumann discloses the claimed invention except for wherein the deflection mirror and the binocular head are fixedly and unchangeably positioned. Blaha discloses a tube for a microscope (figs. 1-3) which includes a locking system to place the tube into a fixedly and unchangeably position (column 2, lines 25-28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the locking system of Blaha to the tube of Baumann to be able to assure a relaxed and convenient posture while working with the microscope (Blaha, column 1, lines 58-60).

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann in view of Blaha as applied to claim 9 above and further in view of Brinkmann et al., WO 03/003099 (henceforth Brinkmann). **NOTE:** US 2004/0240048 A1 (Dietrich et al.) is the English equivalent of the prior art and will be referred to in the rejection.

Baumann discloses the claimed invention except for wherein angle  $\alpha$  of the binocular head between the horizontal and the ocular optical path can be fixedly preset to between  $7.5^\circ$  and  $20.0^\circ$ . Brinkmann teaches a fixed microscope tube (figs. 1-6) in which a fixed viewing angle of  $20.0^\circ$  is provided (page 1, section [0007], lines 3-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to fixedly preset the angle  $\alpha$  of Baumann to  $20.0^\circ$  as suggested by Brinkmann as it is an ergonomically favorable angle and will prevent maladjustments by users (Dietrich, page 1, section [0007], lines 5-8).

***Response to Arguments***

10. Applicant's arguments filed 2 September 2008 have been fully considered but they are not persuasive.

Applicant argues that Baumann does not anticipate claim 1 because Baumann does not include a deflection mirror provided behind the objective optical path, when viewed from the user's position. The examiner respectfully disagrees. First, the user's position is not defined in the claim. As such, this position cannot be assumed to always be behind the eyepiece. A user placing a slide in the microscope might do so from a different position making the deflection mirror behind the objective optical path. Further, even if one does assume that the user's position is at the eyepiece, the deflection mirror may still be considered behind the objective optical path as it is downstream in the optical train (i.e., further behind in the direction of light travel). Therefore the rejection meets all the claim requirements and is maintained.

11. It is noted by the Examiner that the drawing and specification objections made in the previous Office Action have been withdrawn due to amendment by the Applicant.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO



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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE FINEMAN whose telephone number is (571)272-2313. The examiner can normally be reached on Monday - Friday 8:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lee Fineman/  
Examiner, Art Unit 2872  
30 October 2008